REMARKS

This Reply is in response to the Office Action mailed on December 2, 2009 in which claims 1-8, 10-16, 18-35 were rejected. With this response, claims 2-4, 9, 17, 20-26, and 33-34 are canceled; claims 1, 14 and 27 are amended; and claims 36-38 are added. Claims 1, 5-8, 10-16, 18-19, 27-32 and 35-38 are presented for reconsideration and allowance.

I. Request for information under 37 CFR 1.105

Page 3 of the Office Action requested a copy of "PML Protocol Specification, Hewlett-Packard Company, 11/18, 19998, Revision 2.3" pursuant to 37 CFR 1.105. In response, the citation of the requested document is deleted from the specification. The requested document cannot be readily obtained. It should be no surprise that the document is not readily available and is no longer present on the cited website since this is the first request for the document since the original filing over 10 years ago. During this time, the prosecution has included nine office actions and two reinstated appeals.

II. Rejection of claims 1-8, 10-16, 18-23 and 25-35 under 35 USC 112, first paragraph

Page 4 of the Office Action rejected claims 1-8, 10-16, 18-23 and 25-35 under 35 USC 112, first paragraph as allegedly not complying with the written description requirement. In particular, the Examiner asserts that there is no evidence that a PML protocol ever existed. Claims 20-23 and 25-26 are canceled.

The rejection is improper and should be withdrawn for several reasons. First, none of the **claims** specifically recite or require the "PML protocol" alleged by the Examiner as not being sufficiently described.

Second, although the claims recite configuring a hard copy output engine, such configuring can be done using many different protocols and in many different manners. One of ordinary skill in the art understands this fact. Moreover,

Applicant's specification itself discloses that such configuration merely utilizes "an object-oriented request-reply protocol supporting asynchronous printer query, control and monitor capabilities." (Page 5, lines 8-12). The PML protocol is only one example protocol employed in one embodiment. The previously cited document, "PML Protocol Specification, Hewlett-Packard Company, Nov. 18, 1998, Revision 2.3", the reference to which is now been removed from the specification, is but one example of a PML protocol.

Third, those of ordinary skill in the art at the time of the filing of the present application clearly understood what a PML protocol constituted. The Examiner contends that there is "no evidence that the PML protocol ever existed". Applicants respectfully refer the Examiner's attention to the following patents, each of which issued prior to the filing of the present application and each of which mentions or describes a "printer manager language" or "peripheral management language" protocol, commonly preferred to as PML protocol: US Patent 6671060; US Patent 6641312; US Patent 6618360; US Patent 6587972; US Patent 6580726; US Patent 6559965; US Patent 6502128; US Patent 6493517; US Patent 6487609; US Patent 6453129; US Patent 6421135; US Patent 6370592; US Patent 6282042; US Patent 6160629; and US Patent 6094548.

Accordingly, the rejection of claims 1-8, 10-16, 18-19 and 27-35 under 35 USC 112 first paragraph should be withdrawn.

III. Rejection of claims 21-23, 25 and 26 under 35 USC 101

Page 5 of the Office Action rejected claims 21-23, 25 and 26 under 35 USC 101 based on the contention that since Applicants' specification describes the claimed medium COULD be carrier wave, the claimed article of manufacture covers only a carrier wave and does not fit into a statutory category of invention. Although claim 21-23, 25 and 26 are canceled, rendering the rejection moot, Applicants refer the Examiner's attention to page 6, line 15-19 which describes the medium as comprising other structures which clearly fall within statutory categories of invention.

The allegation that a claim COULD be construed so as to cover a non-statutory matter is insufficient to reject a claim under 35 USC Section 101.

IV. The Office Action Is Incomplete.

The present Office action should be withdrawn because the Office Action is incomplete. 37 CFR 1.104 recites:

> (a) *Examiner's action*.
>
> (1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.
>
> (2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.
>
> ....
>
> (b) *Completeness of examiner's action*. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.
>
> (c) *Rejection of claims*.
>
> (1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

> (2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(Emphasis added).

In the present case, the Office Action is incomplete as to all matters since the Office Action fails to address the limitations of former claims 32-34.

In rejecting claims 32-34, the Office Action simply says that such claims are rejected "for the same reasoning as claims 1-4 and 6." (Office Action dated December 2, 2009, page 6). However, the additional limitations found in claim 32-34 are not found in any of claims 1-4 or 6. The Office Action fails to address the limitations of claim 32-34 and is therefore incomplete.

Accordingly, Applicants respectfully request that the next Office Action either allow the case or be non-final in nature to provide Applicants with a FAIR opportunity to respond to the Examiner's response to any possible rejection of claims 32-34. A subsequent Final office action would deny Applicants with a fair opportunity to amend the claims and have such claim amendments entered upon learning, for the first time, any rejection of claim 32-34.

V. Rejection of claims 1-4, 6, 8, 10, 11, 14-16, 21-23 and 27-35 under 35 USC 102(a) and (e) based upon Shimamura

Page 6 of the Office Action rejected claims 1-4, 6, 8, 10, 11, 14-16, 21-23 and 27-35 under 35 USC 102(a) and (e) as being anticipated by Shimamura US Patent Publication 20015003827. Claims 2-4, 21-23 and 33-34 are canceled. Claims 1, 6, 8, 10, 11, 14-16, 27- 32 and 35, as amended, overcome the rejection.

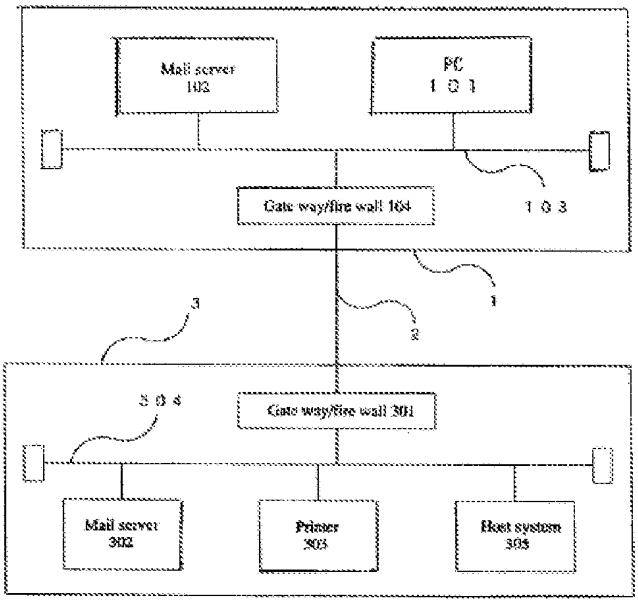
A. Claims 1 and 8

Claim 1 is amended to incorporate the limitations of claim 2. Claim 1, as amended, recites a method of configuring a hard copy output engine, wherein an e-mail containing hardcopy output engine configuration data is received at a hard copy output engine and wherein the hard copy output engine is configured using an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data.

Claim 8 recites an apparatus which configures a hard copy output engine using configuration data received as part of an electronic message by an embedded web server contained in the hardcopy output engine.

Shimamura fails to disclose a method a method of configuring a hard copy output engine, wherein an e-mail or electronic message containing hardcopy output engine configuration data is received at a hard copy output engine and wherein the hard copy output engine is configured using an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data. Nowhere does Shimamura disclose an embedded web server in a hardcopy output engine that receives an e-mail containing configuration data and that configures the hardcopy output engine using the configuration data. In direct contrast, as shown below, Shimamura specifically requires a mail server 302 SEPARATE from printer 303.

[Figure 1]



Shimamura requires that all e-mails be received by the mail server. Shimamura further requires that the printer 303 must then retrieve e-mails from the mail server.

In rejecting former claim 2 (now claim 1), the Office Action contends that the limitation "embedded Web server" is "broad enough to encompass anything which receives e-mail over a network." (Office Action dated December 2, 2009, page 6). In doing so, the Office Action cites selected portions of the specification in support of its contention.

However, the Office Action's construction of the limitation "embedded Web server" is improper as it contradicts (1) the plain meaning of this claim limitation as well as (2) the definition for this claim limitation set forth in the specification.

First, one of ordinary skill in the art would recognize that an "embedded Web server" is not merely "anything which receives e-mail over a network." Those of ordinary skill dark understand the difference between "anything which receives e-mail over a network" and a "server." In fact, the reference cited by the Office Action, Shimamura, itself recognized this difference. Note that Shimamura distinguishes

between a "mail server" 302 (shown above) and an "e-mail transmitter/receiver" 401 which is part of the printer 303 of Shimamura.

Second, the Office Action's attempt to point to Applicants' own specification in support of its broad definition for the limitation "embedded Web server" omits the specification's key definition for the term. Applicants respectfully refer the Examiner's attention to page 7, line 15-16 of Applicants specification which specifically defines a "web server" as "a specialized program running on a server that supports TCP/IP protocol." The Examiner's definition of an "embedded Web server" contradicts Applicant definition for a web server.

Accordingly, claims 1 and 8, as amended, overcome the rejection. Claim 6 and claims 10-11 depend from claims 1 and 8, respectively, and overcome the rejection for at least the same reasons.

B. Claim 14

Claim 14 is amended to incorporate the limitations of former dependent claim 20. Claim 14, as amended, recites a system having processing circuitry that employs a software module to receive an e-mail including hardcopy output engine configuration data through a firewall using an embedded web server and to configure the hardcopy output engine using the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

Shimamura fails to disclose a system having processing circuitry that employs a software module to receive an e-mail including hardcopy output engine configuration data through a firewall using an embedded web server and to configure the hardcopy output engine using the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

First, as noted above, Shimamura fails to disclose an embedded web server in a hardcopy output engine that receives an e-mail including hardcopy output engine configuration data. As noted above with respect to the rejection of claims 1 and 8, Shimamura requires a separate mail server 302, wherein the printer 303 must retrieve mail messages from the mail server. As also noted above, the Examiner's construction of the limitation "embedded Web server" does not comport with the plain meaning of the limitation or the meaning of the limitation as defined in the specification.

Second, Shimamura fails to disclose that configuration data received as part of an e-mail through a firewall is used to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed. Shimamura says nothing about setting a threshold for any of the claimed elements. In contrast, Shimamura merely discloses that an e-mail may be used to either request various information from a printer or may be used to transmit "firmware update" to printer 303.

Moreover, in rejecting former claim 20 (now claim 14) the Office Action fails to address the actual limitations of former claim 20. Rather, the Office Action makes a conclusory assertion that the claimed elements are well known peripheral parameters. Although it may be true that pigmentation material, marking material, number of hours of operation and number of sheets of print media are known printer parameters, the Office Action has failed to articulate any evidence of the setting of threshold levels for the claimed elements (pigmentation material, marking material, number of hours of operation and number of sheets of print media) using configuration data transmitted as part of an e-mail through a firewall and received by an embedded web server in a printer. Accordingly, claim 14, as amended, overcomes the rejection.

C. Claim 27

Claim 27 is amended to incorporate the limitations of former claim 34 and intervening claim 33. Claim 27, as amended, recites a method wherein input is provided from the second side of the firewall (the side of the firewall containing the hardcopy output engine) to the first side of the firewall (the side of the firewall in which the hardcopy output engine configuration data is formed) by interacting with a website on the first side of the firewall with a web browser on the second side of the firewall.

Shimamura fails to disclose a method wherein input is provided from the second side of the firewall (the side of the firewall containing the hardcopy output engine) to the first side of the firewall (the side of the firewall in which the hardcopy output engine configuration data is formed) by interacting with a website on the first side of the firewall with a web browser on the second side of the firewall. As noted above, the Office Actions rejection of former claim 34 fails to even address the limitations of claim 34. Accordingly, claim 27, as amended, overcomes the rejection. Claims 28-32 and 35 depend from claim 27 and overcome the rejection for at least the same reasons.

VI. Rejection of claims 5, 7, 12, 13, 18, 20, 25 and 26 under 35 USC 103(a) based upon Shimamura

Page 8 of the Office Action rejected claims 5, 7, 12, 13, 18, 20, 25 and 26 under 35 USC 103(a) as being an patentable over Shimamura US Patent Publication 20015003827. Claims 20, 25 and 26 are canceled. Claims 5, 7, 12, 13, 18 depend from claims 1, 8 and 14 and overcome the rejection for the same reasons just above. Claims 5, 12, 13 and 18 overcome the rejection for the following additional reasons.

A. Claim 5

Claim 5 depends from claim and further recites that the method includes receiving and XML script and configuring the hardcopy output engine include setting a threshold for an element chosen from a group consisting of: pigmentation material,

marking material, number of hours of operation and number of sheets of print media consumed.

In acknowledgment that Shimamura fails to disclose either (1) the receiving of an electronic message including an XML script including hardcopy output engine configuration data or (2) the use of the XML script of the electronic message to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed, the Examiner contends that such differences are "well-known concepts" and are "ubiquitous in the peripheral art". (Office Action dated December 2, 2009, page 8)

However, both of the Examiner's contentions fail to address the actual claim limitations. First, the Examiner contends that an XML script was a well-known way to configure a device and since no details about XML scripts are provided in the specification, the applicant "must have assumed one of ordinary skill would have been able to carry out the claimed invention, otherwise the applicant would not met the enablement requirement." (Office Action dated December 2, 2009, page 8).

Applicants acknowledge that one of ordinary skill in the art would be able to create an XML script to configure a hardcopy output engine. Thus, Applicants' enablement of the invention is not at issue. However, the Office Action has failed to establish that the specific use of an XML script to configure a hardcopy output engine was known at the time of the invention, at least as early as October 11, 2001. **Applicants hereby request the Examiner to provide support for the official notice taken that "an XML script was a well-known way to configure a device" as of at least prior to October 11, 2001.** If that support cannot be supplied, Applicants request that the rejection of claim 5 be withdrawn for at least this reason.

Second, the Office Action makes the assertion that the claimed elements are well known peripheral parameters. Although it may be true that pigmentation material, marking material, number of hours of operation and number of sheets of

print media are known printer parameters, the Office Action has failed to articulate any evidence of the setting of threshold levels for the claimed elements (pigmentation material, marking material, number of hours of operation and number of sheets of print media) using configuration data transmitted as part of an electronic message through a firewall and received by an embedded web server in a printer. Accordingly, the rejection of claim 5 should be withdrawn.

B. Claim 12

Claim 12 depends from claim 8 and recites that the processor configured the hardcopy output engine using the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

Shimamura fails to disclose a system having processing circuitry that employs a software module to receive an electronic message including hardcopy output engine configuration data through a firewall using an embedded web server and to configure the hardcopy output engine using the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

First, as noted above, Shimamura fails to disclose an embedded web server in a hardcopy output engine that receives an e-mail including hardcopy output engine configuration data. As noted above with respect to the rejection of claims 1 and 8, Shimamura requires a separate mail server 302, wherein the printer 303 must retrieve mail messages from the mail server. As also noted above, the Examiner's construction of the limitation "embedded web server" does not comport with the plain meaning of the limitation or the meaning of the limitation as defined in the specification.

Second, Shimamura fails to disclose that configuration data received as part of an electronic message through a firewall is used to set a threshold for an element

chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed. Shimamura says nothing about setting a threshold for any of the claimed elements. In contrast, Shimamura merely discloses that an e-mail may be used to either request various information from a printer or maybe used to transmit "firmware update" to printer 303.

Moreover, in rejecting former claim 12, the Office Action fails to address the actual limitations of former claim 12. Rather, the Office Action makes a conclusory assertion that the claimed elements are well known peripheral parameters. Although it may be true that pigmentation material, marking material, number of hours of operation and number of sheets of print media are known printer parameters, the Office Action has failed to articulate any evidence of the setting of threshold levels for the claimed elements (pigmentation material, marking material, number of hours of operation and number of sheets of print media) using configuration data transmitted as part of an electronic message through a firewall and received by an embedded web server in a printer. Accordingly, claim 12 overcomes the rejection for at least this additional reason.

C. Claims 13 and 18

Claim 13 depends from claim 8 and further recites use of an XML script as part of the electronic message, wherein the XML script is used to configure the hardcopy output engine.

Claim 18 depends in claim 14 recites that the electronic message including hardcopy output engine configuration data includes an XML script.

In acknowledgment that Shimamura fails to disclose the use of an XML script to configure a hardcopy output engine, the Examiner contends that an XML script was a well-known way to configure a device and since no details about XML scripts are provided in the specification, the applicant "must have assumed one of ordinary

skill would have been able to carry out the claimed invention, otherwise the applicant would not met the enablement requirement."

Applicants acknowledge that one of ordinary skill in the art would be able to create an XML script to configure a hardcopy output engine. Thus, Applicants' enablement of the invention is not at issue. However, the Office Action has failed to establish that the specific use of an XML script to configure a hardcopy output engine was known at the time of the invention, at least as early as October 11, 2001. Applicants hereby request the Examiner to provide support for the official notice taken that "an XML script was a well-known way to configure a device" as of at least prior to October 11, 2001. If that support cannot be supplied, Applicants request that the rejection of claims 13 and 18 be withdrawn for at least this reason.

VII. Added Claims

With this response, claims 36-40 are added. Claims 36-40 are believed to be patentably distinct over the prior art of record.

A. Claims 36-37

Claim 36-37 depend from claim 1 and correspond to former claims 32-33 which depended from claim 27.

The prior art of record fails to disclose the method of claims 32-33. Thus, claims 36-37 are presented for consideration and allowance.

C. Claim 38

Claim 38 constitutes former claim 32 rewritten in independent form. As noted above, the Office Action fails to address the actual limitations of claim 32. The Office Action fails to articulate where Shimamura discloses hardcopy output engine configuration data designating a website on the first side of the firewall as a contact for the hardcopy output engine. Accordingly, claim 38 is presented for consideration and allowance.

VIII. Conclusion.

Claims 1, 5-8, 10-16, 18-19, 27-32 and 35-38 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date March 2, 2010

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